UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/612,772	07/02/2003	William A. Montemer	ICHGP004	5008

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EXAMINER
RAJ, RAJIV J

ART UNIT	PAPER NUMBER
3686	

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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

	Application No.	Applicant(s)
Office Action Summary	10/612,772	MONTEMER, WILLIAM A.
	Examiner	**Art Unit**
	RAJIV J. RAJ	3686

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on __*March 09, 2009*__ .
2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.
3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-7* is/are pending in the application.
    4a) Of the above claim(s) *none* is/are withdrawn from consideration.
5)☐ Claim(s) _____ is/are allowed.
6)☒ Claim(s) *1-7* is/are rejected.
7)☐ Claim(s) _____ is/are objected to.
8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.
10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.
    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
    a)☐ All   b)☐ Some * c)☐ None of:
      1.☐ Certified copies of the priority documents have been received.
      2.☐ Certified copies of the priority documents have been received in Application No. _____ .
      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____ .

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application
6)☐ Other: _____ .

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth

in 37 CFR 1.17(e), was filed in this application after final rejection. Since this

application is eligible for continued examination under 37 CFR 1.114, and the fee set

forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action

has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on

March 9, 2009 has been entered.

Status of Claims

2. This action is in reply to the amendment filed on 09 March 2009.

3. Claim 1 has been amended.

4. Claims 3-7 have been added.

5. Claims 1-7 are currently pending and have been examined.

Priority

6. Applicant's claim for the benefit of a prior-filed application under 35 U.S.C. 119(e) or

under 35 U.S.C. 120, 121, or 365(c) is acknowledged.

Claim Rejections - 35 USC § 101

7. 35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

8. Claims 1 & 5-7 are rejected under 35 U.S.C. 101 based on Supreme Court precedent, and recent Federal Circuit decisions, a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. Diamond v. Diehr, 450 U.S. 175, 184 (1981); Parker v. Flook, 437 U.S. 584, 588 n.9 (1978); Gottschalk v. Benson, 409 U.S. 63, 70 (1972); Cochrane v. Deener, 94 U.S. 780,787-88 (1876). The process steps in claims (1 & 5-7) are not tied to a machine nor do they execute a transformation. Thus, they are non-statutory.

Claim Rejections - 35 USC § 103

9. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

10. The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148

USPQ 459 (1966), that are applied for establishing a background for determining

obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

11. Claims 1-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over

Soulanille (US 2001/0051940 A1) (hereinafter Soulanille) in view of Padden et al.

(US 4979206) (hereinafter Padden).

Claim 1

Soulanille as shown, discloses the following limitations:

- *maintaining a database including a plurality of directory listings,* (see at least Soulanille [0042] "In a preferred embodiment of the present invention, search engine web server 24 includes a search database 40 comprised of search listing records used to generate search results in response to user queries.")
- *wherein each listing is associated with a referral phone number, at least one keyword and a bid amount a directory listing owner is willing to pay for a single telephone referral;* (see at least Soulanille [0016] "In a database of search listings in which each search listing is associated with an advertiser and includes at least one search term and a bid amount by the advertiser, search listings generating a match with the search request are identified.")

- *receiving a directory assistance request in the form of a keyword from the customer;* (see at least Soulanille [0016] The method includes receiving a search request from a searcher . . . includes at least one search term")

- *identifying the directory listings having keyword terms generating a match with the request;* (see at least Soulanille [0017] "identifying search listings having search terms generating a match with the search request.")

- *ordering the identified directory listings into a phone number result list in accordance with the values of the bid amounts for the identified directory listings;* (see at least Soulanille [0018] "arranging as the search result list the identified search listings for display in a random order weighted according to the bid amount associated with each respective identified search listing.")

- *selecting one of the directory listings;* (see at least Soulanille [0018] "The method further includes selecting according to bid amount a variable number of identified search listings for display to the searcher, wherein the number of selected identified search listings is a function of the bid amounts for the identified search listings.")

- *generating a paid referral business transaction and associating it with the listing owner's advertising account;* (see at least Soulanille [0044] "Most preferably, the advertiser's web site description and hyperlink on the search result list page is accompanied by an indication that the advertiser's listing is a paid listing. Most preferably, each paid listing displays a "cost to advertiser," which is an amount corresponding to a "price-per-click" paid by the advertiser for each referral to the advertiser's site through the search result list.")

- *generating one or a plurality of derivative business transactions to execute the business processes involved in the referral transaction.* (see at least Soulanille [0014 & [0012] "A consumer utilizing a search engine that

facilitates this on-line marketplace will find companies or businesses that offer the products, services, or information that the consumer is seeking." & "The banner may act a hyperlink a visitor may click on to access the site. Like traditional advertising, banner advertising on the Internet is typically priced on an impression basis with advertisers paying for exposures to potential consumers.")

- *wherein at least one business process involved in the referral transaction comprises a hierarchical multi-step automated process that includes two or more component processes performed in series, a first component process of which is configured to process data comprising a set of transaction data encapsulated as a package; repackage the transaction data, including context data associated with the first component process; and send the repackage transaction and context data to a next component process;* (see at least Soulanille [0066], [0081], Fig:2 Items:120,150-180, Fig:6 Items:602-616, Fig:7 Items:710a-760h & related text)

- *wherein each directory listing in the phone number result list includes an associated set of transaction data;* (see at least Soulanille [0053-0060] Fig:5 Items:320, 325, 340-344, 352-360 & related text)

- *generating a paid referral business transaction includes automatically sending the set of transaction data associated with the selected one of the directory listings to a respective first stage only stage of each of said one or a plurality of derivative business transactions;* (see at least Soulanille Fig:1-5 Items:10-304 & related text)

Soulanille does not disclose the following limitation, however Padden, as shown, does:

- *a directory assistance request from a telephone customer using a computer network* (see at least Padden Column:1 Lines 13-17 "a

customer places a call to an operator and gives the particulars of a

request for a directory listing and the operator keys identifying data into a

computer for locating directory listings.")

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the limitation of Padden with Soulanille. One of ordinary skill in

the art would have added these features to Soulanille with the motivation to provide

an efficient and effective invention for handling transactions utilizing a directory

network. (Padden Column:1 Lines:40-67 Column:2 Lines:1-25).

Claim 2

Soulanille as shown, discloses the following limitations:

- *encapsulate the business transaction parameters in a separate transaction*

  container that can be passed as a complete package to disparately located

  business transactions; send the transaction container to one or a plurality of

  business processes; after executing each business process, include a

  resulting system state as the transaction context for the particular business

  process; and add successive transaction contexts to the transaction container

  in such a way that the sequence of initial state, desired operation, input

  parameters and resulting state fully describes each step of the multi-step

  distributed transaction. (see at least Soulanille [0115] "This pseudocode and

  the method illustrated in FIG. 10 may be adapted to any suitable embodiment.

  In particular, it may be adapted as program code in C++ or Java implemented

  on a web server and operated by a pay for performance search engine

operator" wherein object-oriented programming, such as C++, naturally

discloses the steps of packaging, transporting, and adding additional

business transactions.)

- *one or more processors configured to;* (see at least Soulanille [0037])

Soulanille does not disclose the following limitation, however Padden, as shown,

does:

- *a directory assistance request from a telephone customer using a computer*

  network (see at least Padden Column:1 Lines 13-17)

It would have been obvious to one of ordinary skill in the art at the time of the

invention to combine the limitation of Padden with Soulanille. One of ordinary skill in

the art would have added these features to Soulanille with the motivation to provide

an efficient and effective invention for handling transactions utilizing a directory

network. (Padden Column:1 Lines:40-67 Column:2 Lines:1-25).

Claim 3

The combination of Soulanille/Padden disclose all of the limitations of claim 2. Soulanille

further discloses the following limitations:

- *one or more processors are configured to add successive transaction contexts to the*

  transaction container; (see at least Soulanille Fig:1 Items:10-20 & related text)

- *at least in part by encapsulating said transaction containers;* (see at least Soulanille*

  [0115])

- *any previous encapsulation added thereto in connection with any prior step of the multi-step distributed transaction, in an encapsulation that includes a current step context data;* (see at least Soulanille [0066], [0081], Fig:2 Items:120,150-180, Fig:5 Itmes:300-360 Fig:6 Items:602-616, Fig:7 Items:710a-760h & related text)

Claim 4

The combination of Soulanille/Padden disclose all of the limitations of claim 3. Soulanille further discloses the following limitations:

- *said current step context data includes one or more of an initial state, a desired operation, input parameters, and a resulting state associated with the current step;* (see at least Soulanille Fig:8-10 Items:200-230, 810-920 & related text)

Claim 5

The combination of Soulanille/Padden disclose all of the limitations of claim 1. Soulanille further discloses the following limitations:

- *set of transaction data comprises a referral transaction container that encapsulates the set of transaction data;* (see at least Soulanille [0066], [0081], Fig:2 Items:120,150-180, Fig:5 Itmes:300-360 Fig:6 Items:602-616, Fig:7 Items:710a-760h & related text)

Claim 6

The combination of Soulanille/Padden disclose all of the limitations of claim 5. Soulanille further discloses the following limitations:

- *the container encapsulates all data required to process said paid referral business transaction;* (see at least Soulanille see at least Soulanille [0012], [0014], [0016], [0044])

Claim 7

The combination of Soulanille/Padden disclose all of the limitations of claim 1. Soulanille further discloses the following limitations:

- *wherein said next component process is configured to process the transaction data and repackage the transaction data by encapsulating the transaction data and the context data associated with the first component process in an encapsulation that includes a next component process context data associated with the next component process;* (see at least Soulanille [0115], [0066], [0081], Fig:2 Items:120,150-180, Fig:5 Itmes:300-360 Fig:6 Items:602-616, Fig:7 Items:710a-760h & related text)

Response to Arguments

12. Applicant's arguments received on 09 March 2009 have been fully considered but they are not persuasive. Applicants' arguments will be addressed herein below in the order in which they appear in the response filed 09 March 2009.

13. In response Applicant's argument that the prior Office Action does not address "each directory listing in the phone number result list includes an associated set of transaction data" and "generating a paid referral business transaction includes automatically sending the set of transaction data associated with the selected one of

the directory listings to a respective first or only stage of each of said one or a

plurality or derivative business transactions." Examiner respectfully points out that

this amended claim language was not found in the Applicant's previous submission,

which is why it was not addressed in the Non-Final Office Action. Examiner further

points out that the claim language is addressed by the prior art in this Office Action

14. In response to Applicant's argument that the cited prior art fails to teach "*hierarchical*

multi-step automated process", Examiner respectfully points out that C++ and Java

executing the program in the prior art disclose these steps. (see at least Soulanille

[0115] & Fig:9 Items:900-920 & related text)

15. In response to Applicant's argument that the cited prior art fails to teach "*a resulting*

system state as the transaction context for the particular business process"

Examiner respectfully points out that C++ and Java implicitly disclose these steps.

(see at least Soulanille [0115])

16. Applicant's argues for the allowability of claims 3 & 4, on the basis for the allowability

of claim 2, and thus these claims are rejected on the same grounds.

17. In response Applicant's argument that the prior Office Action does not address

"successive transaction contexts being added". Examiner respectfully points out that

this amended claim language was not found in the Applicant's previous submission,

which is why it was not addressed in the Non-Final Office Action. Examiner further

points out that the claim language is addressed by the prior art in this Office Action

18. In response to Applicant's argument that the cited prior art fails to teach the

language of claim 4, Examiner respectfully points out that this amended claim

language was not found in the Applicant's previous submission, which is why it was

not addressed in the Non-Final Office Action. Examiner further points out that the

claim language is addressed by the prior art in this Office Action

19. Applicant's argues for the allowability of claims 5-7 on the basis for the allowability of

claim 1, and thus these claims are rejected on the same grounds.

20. In response to Applicant's argument that the cited prior art fails to teach the

language of claims 5-7, Examiner respectfully points out that this amended claim

language was not found in the Applicant's previous submission, which is why it was

not addressed in the Non-Final Office Action. Examiner further points out that the

claim language is addressed by the prior art in this Office Action

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to **Rajiv J. Raj** whose telephone number is **(571) 270-3930.** The Examiner can normally be reached on Monday-Friday, 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the Examiner's supervisor, **Jerry O'Connor** can be reached at **571.272.6787**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://portal.uspto.gov/external/portal/pair <http://pair-direct.uspto.gov >. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at **866.217.9197** (toll-free).

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks

Washington, D.C. 20231

or faxed to **(571) 273-8300**.

Hand delivered responses should be brought to the **United States Patent and Trademark Office Customer Service Window**:

Randolph Building

401 Dulany Street

Alexandria, VA 22314.

Date: 04/07/09
/RJR/
Patent Examiner Art Unit 3686

/Gerald J. O'Connor/
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